

# Notice of Allowability

Application No.

09/988,496

Examiner

Joseph T. Weitach

Applicant(s)

ANDERSON ET AL.

Art Unit

1632

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 7/17/2006.
2. ☒ The allowed claim(s) is/are 39,73,89,90,93 and 95-97.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

Art Unit: 1632

### **DETAILED ACTION**

This application filed November 20, 2001, claims benefit to provisional application 60/252,009, filed November 20, 2000.

Applicants' after final amendment filed June 17, 2006 has been received and entered. Claims 1-38, 40-72, 74-78, 91, 92 and 94 have been cancelled. Claims 39, 73, 89, 90, 93, 95-97 are pending.

### ***Election/Restriction***

Applicant's election with traverse of Group V in the reply filed on October 3, 2003 was acknowledged. No new arguments in traverse of the requirement have been provided by Applicants, nor have claims directed to non-elected inventions been added.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 39, 73, 89, 90, 93, 95-97 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16, 18-24 of U.S. Patent No. 6,887,674 B1 (issued May 3, 2005) is withdrawn.

Applicants summarize the teachings of '674, detailing the differences between the interpretation of working example 7 and the basis of the present disclosure, and argue that the instant methods are drawn to assessing an effect of an agent on arterial smooth muscle cells which was not set forth in '674, nor could it have been construed by the general teachings or working examples. See Applicants' amendment, pages 2-3.

Applicants' arguments have been fully considered, and found persuasive.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

Claims 39, 73, 89, 90, 93, 95-97 rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter is withdrawn.

Applicants summarize the teachings of '674, detailing the differences between the interpretation of working example 7 and the basis of the present disclosure, and argue that the inventorship as presently set forth is correct See Applicants' amendment, pages 3-4.

Applicants' arguments have been fully considered, and found persuasive.

Claims 39, 73, 89, 90, 93, 95-97 rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,887,674 B1 is withdrawn

Similar to the traverse of the double patenting rejection, Applicants summarize the teachings of '674, detailing the differences between the interpretation of working example 7 and the basis of the present disclosure, and argue that the instant methods are drawn to assessing an effect of an agent on arterial smooth muscle cells which was not set forth in '674, nor could it have been construed by the general teachings or working examples. See Applicants' amendment, pages 4-5.

Applicants' arguments have been fully considered, and found persuasive.

#### ***Examiner's Amendment***

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Z. Angela Guo on October 12, 2005.

The application has been amended as follows:

In claim 73, delete the first recitation of [A], and insert --The-- therein.

***Reasons for Allowance***

The following is an examiner's statement of reasons for allowance:

As indicated previously, the claims are free of the art of record, because the prior art fails to teach Ephrin B2, in particular as a target of agents that affect smooth muscle. The claims have been amended to address the basis of the rejections made under 35 USC 112. With regard to 35 USC 112, first paragraph, the claims set forth subject matter supported by the present specification for an assay wherein disclosed Ephrin B2 activities are measured in smooth muscle cells. The claims now clearly set forth active method steps that are not anticipated or made obvious by the prior art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached at (571) 272-0735.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571) 272-0532.

Joseph T. Woitach



**JOSEPH WOITACH, Ph.D.  
PRIMARY EXAMINER**